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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,545	07/30/2003	Yoshiyuki Asahina	0152-0654P	6525

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EXAMINER
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NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/629,545

**Applicant(s)**

ASAHINA ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-14 is/are rejected.
- 7) ☒ Claim(s) 3-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-30-03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5710209 Blum et al..

Blum et al. discloses primers having a polyurethane polyol having the instantly claimed number of hydroxyl groups, the instantly claimed OH value, the instantly claimed number average molecular weight, based on the typical polydispersities of such urethanes, a urethane content of 2.5-15 weight percent, and an acid number of 7-70. See the abstract; column 1, lines 51-67; column 2, lines 1-67; column 3, lines 1-67; column 4, lines 1-67, particularly 10-21, 44-46, and 60-63; column 5, lines 1-67, particularly 55-59; column 6, lines 1-67; column 7, line 1 to column 9, line 67, particularly column 9, lines 28-67, which encompasses the use of the compositions of the patentee as a car primer; column 10, lines 1-39 and 55-67; column 11, lines 1-62; column 12, lines 7-67; column 13, lines 1-9 and 22-50; and the remainder of the document. The patentee does not disclose the instantly claimed equivalent ratio of (urethane group)/(hydroxyl group+ hydrophilic group). The patentee does encompass this value with the disclosed hydroxyl value, molecular weight, urethane content, and acid number as well as the

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exemplified OH groups used in the polyurethane. It would appear that the examples may also encompass this value, given their similarities in disclosed parameters to those of the instant claims.

4. Claims 1-2 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5710209 Blum et al..

Blum et al. discloses primers having a polyurethane polyol having the instantly claimed number of hydroxyl groups, the instantly claimed OH value, the instantly claimed number average molecular weight, based on the typical polydispersities of such urethanes, a urethane content of 2.5-15 weight percent, and an acid number of 7-70. See the abstract; column 1, lines 51-67; column 2, lines 1-67; column 3, lines 1-67; column 4, lines 1-67, particularly 10-21, 44-46, and 60-63; column 5, lines 1-67, particularly 55-59; column 6, lines 1-67; column 7, line 1 to column 9, line 67, particularly column 9, lines 28-67, which encompasses the use of the compositions of the patentee as a car primer; column 10, lines 1-39 and 55-67; column 11, lines 1-62; column 12, lines 7-67; column 13, lines 1-9 and 22-50; and the remainder of the document. The patentee does not disclose the instantly claimed equivalent ratio of (urethane group)/(hydroxyl group+ hydrophilic group). The patentee does encompass this value with the disclosed hydroxyl value, molecular weight, urethane content, and acid number as well as the exemplified OH groups used in the polyurethane. It would appear that the examples may also encompass this value, given their similarities in disclosed parameters to those of the instant claims.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of polyurethane parameters in the

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polyurethane of the patentee because they are encompassed by the patentee and would have been expected to give the coating properties disclosed by the patentee. There is no evidence, which is commensurate in scope with the instant claims and the cited prior art, that the instantly claimed combination of parameters gives an unexpected result over the compositions of Blum discussed above.

5. Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is no motivation to make the polyurethane of Blum using the parameters of the instant claims 3-6 nor other teaching to do so.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Patrick D. Niland', is positioned above the printed name.

Patrick D. Niland  
Primary Examiner  
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